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REMARKS

Receipt of the Office Action mailed October 3, 2003, in the above-identified patent application is respectfully acknowledged. A Petition and Fee for a one-month extension of time in which to file this Response is enclosed. Claims 1-3, 8-10, 15, 17, 18, 25, 53 and 54 remain in the application. Claims 1 and 18 have been amended herein. Claims 55-58 have been newly added herein. Claims 4-7, 11-14, 16, 19-24, 26-33, 51 and 52 have previously been cancelled. Claims 34-50 have previously been withdrawn as directed to a non-elected invention. Reconsideration of the remaining claims based on the above amendments and the following remarks and a Notice of Allowance is respectfully requested.

Amendment of the Specification

The specification at page 6, lines 19-29, has been amended to refer to the issued patent number for the application referred to and incorporated by reference in that paragraph.

The Claim Rejections Under 35 U.S.C. § 103

Claims 1-3, 8-10, 17, 18, 53 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi et al. U.S. 6,590,622 in view of Denton U.S. 4,802,737. Applicant has now amended claim 1, and thus the claims dependent thereon, to state that each transparent, thin film layer of the first stack and the second stack is a wet chemical formed thin film layer, and the transparent conductive film on the third thin film layer of the first stack is a vacuum deposited thin film. Claim 18, and thus the claims dependent thereon, has been amended to state that each of the first through sixth thin films is a wet chemical formed thin film, and the transparent conductive coating is a vacuum deposited coating. Further, new claims 55 and 57 further define the wet chemical formed thin film layers/thin films as comprising angle dipped thin film layers/thin films wherein the substrate is dipped into a liquid solution of a precursor of the respective first, second or third thin film layers (claim 55) or the first and second or third and fourth or fifth and sixth thin films (claim 57) while maintaining the substrate at a predetermined angle to the vertical to simultaneously coat each of the first and second surfaces of the substrate, or the previous thin film layers or thin films on the first and second surfaces of the substrate, following which the coated layers are cured with at least one of ultraviolet light, air drying and heating/firing. In addition, claims 56 and 58 have been added which are respectively dependent on claims 55 and 57, further defining the vacuum deposited thin film/coating as comprising a sputtered thin film/coating.

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As amended, claims 1 and 18, as well as the remaining claims dependent thereon, and new claims 55-58, are not taught or suggested by Nakanishi et al. '622 or Denton '737. Indeed, the Examiner recognizes that the films used in Nakanishi et al. and Denton are different from and have differing thicknesses from Applicant's thin films/thin film layers. As now stated in the amended claims, Applicant's thin film layers or thin films are wet chemical formed thin film layers/thin films and the transparent conductive thin film is a vacuum deposited thin film/coating such that, the entire combination of layers and deposition processes is significantly different from and unobvious in view of the either Nakanishi et al. '622 or Denton '737.

More specifically, Nakanishi et al. '622 discloses a transparent touch panel including a fixed substrate comprising transparent plastic, an adhesion layer disposed on the fixed substrate, an anti-reflection layer disposed on the adhesion layer, a first transparent conductive layer disposed on the anti-reflection layer and a second transparent conductive layer provided opposed to and spaced from the first transparent conductive layer on flexible transparent film. Nakanishi et al. specifically state that their adhesion layer supports the tight adhesion of the anti-reflection layer and first transparent conductive layer onto the fixed substrate. The anti-reflection layers are formed by repetitive sputtering as set forth in Nakanishi et al. at column 4, lines 27-30.

Accordingly, the structure of Nakanishi et al. '622 is significantly different from that of Applicant's claimed coated panel because Nakanishi et al. '622 requires an adhesion layer for proper adherence of its anti-reflective layers to its substrate, and fails to mention in any respect that its anti-reflective films are on opposite sides of the same substrate, or that the film thickness of any one of its layers is different from the thickness of a corresponding thin film layer on the opposite surface of the substrate as is claimed by Applicant in both claims 1 and 18 as amended. In Applicant's claims, the corresponding films or thin film layers are of the same material composition on each surface of the substrate and are wet chemical formed thin films/thin film layers. Nakanishi et al. merely discloses sputtering, printing or coating of coatings on one surface. Moreover, because Nakanishi et al. disclose alternating layers formed by repetitive sputtering, the required arrangement of refractive indices as set forth in Applicant's claims 1 and 18, as amended, is also not disclosed or suggested by Nakanishi et al. Further, since Applicant's thin film layers or thin films are wet chemical formed thin films/layers, as set forth in Applicant's claims 1 and 18, as

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amended, Applicant's coated panel allows increased light transmission therethrough as compared to a substrate coated only with transparent conductive thin film, all as set forth in Applicant's specification. Indeed, new claims 55 and 57 set forth specifically that Applicant's wet chemical formed thin films/thin film layers are angle dipped thin films/layers wherein simultaneous coating of the first and second surfaces or the previous thin film layers or thin films on the surfaces of the substrate is enabled to create the differing thicknesses set forth in Applicant's claims 1 and 18, as amended, in a manner that is nowhere disclosed or suggested in Nakanishi et al.

In addition, the disclosure of Denton 4,802,737 fails to complete the lack of disclosure missing from Nakanishi et al. with respect to Applicant's claimed coated panels in amended claims 1 and 18 and the claims dependent thereon. Denton '737 discloses an anti-reflection overlay device which is stated to reduce light reflection as seen by a viewer of a work of art. Denton includes a section of etched glass proposed for use as an overlay for a picture frame including art work, the etched glass having a coating of non-reflection material on both sides of its front and rear surfaces. However, Denton fails to disclose the elements of Applicant's amended claims 1 and 18, or the remaining dependent claims, especially where the film thicknesses of any one of the film layers on one surface of the substrate is different from the thickness of the corresponding thin film layer or thin film on the other surface of the substrate. As recognized by the Examiner at page 3 of the Office Action, Denton fails to disclose any thickness difference, but rather states that the multi-layer coating follows the general anti-reflective configuration of one quarter wavelength for the first layer, one half wavelength for the second layer, and one quarter wavelength for the third layer. These layers are the same on both sides of the glass. The wavelength, and the specific thicknesses, are not provided. Consequently, it is clear that the thicknesses of the layers on each surface of Denton are taught to be the same unlike Applicant's claimed invention in amended claims 1 and 18 and claims dependent thereon.

It is also clear that there is no suggestion or motivation for substituting the anti-reflective overlay device used for displaying artwork in the touch panel application of Nakanishi et al. '622 contrary to the Examiner's assertion on page 3 of the Office Action that it would have been obvious to one having an ordinary skill in the art at the time the invention was made to use Denton's coatings. As explained by Applicant in her specification, the use of different thin film/thin film layer thicknesses on the respective sides or surfaces of the

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substrate reduces glare from light incident on the coated substrate in Applicant's invention and increases visible light transmission by significant amounts. See specification at page 8, lines 6-31 and page 9, lines 1-5. Indeed, the increase in light transmittance is greater than that disclosed in either Nakanishi et al. '622 or Denton '737.

In addition, contrary to the assertion by the Examiner, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the thicknesses of the layers in view of either Nakanishi et al. or Denton since neither provides a motivation for or suggestion for making such changes to the thin film layers in their respective disclosures. Denton actually teaches away from Applicant's invention by including corresponding layers of the same thickness on opposite sides of its substrate. A general understanding that thicknesses determine various properties does not in any sense disclose or suggest the combination of thicknesses or other features set forth in Applicant's amended claims 1 and 18, especially where the thin film layers or thin films are wet chemical formed thin films/layers and the light transmission is increased as set forth by the Applicant. The Examiner's unsupported conclusion that one of ordinary skill in the art understands that layer thicknesses determine properties such as transmittance, reflectance and color and that discovering an optimum value of a result effective variable involves only routine skill in the art does not provide substantial evidence of obviousness sufficient to support this rejection. The Federal Circuit has clearly held that factual findings by the Patent Office that aspects of an invention are "basic knowledge" or "common sense" to one of ordinary skill in the art do not generally satisfy the substantial evidence standard. See *In re Zurko*, 258 F.3d 1379, 59 USPQ 2d. 1693 (Fed. Cir. 2001) where the court reversed the judgment of the Board of Appeals holding that the Board's conclusion of obviousness was based on a misreading of the references relied upon and, therefore, lacked substantial evidence support, and stated as follows:

[T]he deficiencies of the cited references cannot be remedied by the Board's conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art....We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to

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peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience--or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. (emphasis added) USPQ 2d at 1697

Because the Examiner points to no statement or suggestion Nakanishi et al. or Denton to combine one with the other, or, more importantly, to provide thin film layers having differing thicknesses in the arrangement set forth in Applicant's claims 1 and 18, as amended, where those layers are wet chemical formed thin films/layers, *In re Zurko* shows there is a lack of concrete evidence in the record to support such a combination, and that even if the cited references were so combined, the coated panel claimed by Applicant would not result.

Similarly, the Examiner provides no factual basis for taking official notice that one of ordinary skill in the art knows that the layer thicknesses of a transparent coated glass article determine properties such as transmittance, reflectance and color. Moreover, even if such knowledge is accurate, there is no evidence in the record that providing the combination of wet chemical formed thin film layers with a vacuum deposited transparent conductive thin film as claimed by Applicant in amended claims 1 and 18, or the claims dependent thereon including new claims 55-58, would result. In this case, because the Examiner provides no proof or evidence supporting what is "known to one of ordinary skill" regarding layer thicknesses of a transparent coated glass article determining such properties, the Examiner's statement does not provide proper support for the rejection. It is respectfully submitted that the rejection should be withdrawn.

For the same reasons, dependent claims 2, 3, 8-10, 17, 53 and 54, which depend from claim 1, are also allowable over Nakanishi et al. or Denton taken alone or in any combination. The mere fact that Nakanishi et al. disclose a touch panel can be made of glass does not provide disclosure or suggestion for the remaining elements or the combinations set forth in Applicant's amended claims.

With respect to claims 15 and 25, the addition of Matsufuji et al. 6,480,250 also does not complete the lack of disclosure missing from Nakanishi et al. and/or Denton. Rather, Matsufuji et al. '250 discloses only that a conductive layer may be formed directly on

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the front panel of a cathode ray tube or plasma display as used in TV sets or computer displays. The Matsufuji et al. '250 invention itself relates to a multilayer film on a transparent substrate, the multilayer film comprising a series of layers significantly different from Applicant's invention as claimed in amended claims 1 and 18. See Matsufuji et al. '250 at column 2, lines 44-51. Moreover, there is no disclosure or suggestion in Matsufuji et al. for combining its multilayer film on a substrate with the films of either Nakanishi et al. '622 or Denton '737 and, therefore, there is no evidentiary basis to combine Matsufuji et al. with either reference. This is especially true with respect to Applicant's claimed layers having different thicknesses and being wet chemical formed thin films/layers. Accordingly, it is respectfully submitted that it would not have been obvious to one having ordinary skill in the art to combine Matsufuji et al. with either Nakanishi et al. or Denton and that adding a transparent conductive coating to Applicant's combination as set forth in claims 15 and 25 is not obvious to one skilled in the art in view of any of those references taken alone or in combination.

The same is true regarding the Examiner's rejection of claims 1-3, 8-10, 17, 18, 53 and 54 as being obvious to one skilled in the art over Byker et al. U.S. 5,805,330 in view of Denton '737. Byker discloses an electro-optic window having first and second transparent spaced elements 12, 14 which receive an electro-optic material therebetween, the inside faces of each transparent element including a transparent electrically conductive layer. In addition, Byker discloses that an optional layer or layers of an anti-iridescent, an anti-reflection and/or a color suppression material may be deposited between the transparent conductive material and the face of the transparent element on which the conductive material is coated. As such, Byker et al. does not disclose the combination of thin film layers or thin films on first and second surfaces of one transparent substrate where the film thickness of any one of the thin film layers on one surface is different from the corresponding thin film layer on the other surface and wherein the thicknesses and refractive indices are as set forth in Applicant's amended claims 1 and 18, especially where such thin film layers are wet chemical formed thin films/layers. Moreover, there is no suggestion or motivation for including thin film layers as set forth in Applicant's amended claims on both surfaces of any of the transparent elements 12 or 14 in Byker et al.

As discussed above, Denton '737 also does not disclose Applicant's wet chemical formed thin film layers or thin films having the thicknesses and refractive indices

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and arrangement as set forth in Applicant's amended claims 1 and 18, or the claims dependent thereon. As also noted above, Denton '737 does not include any motivation or suggestion for including varying thicknesses as set forth in these claims and, therefore, it is respectfully submitted that there is no basis to combine the disclosures of Denton with Byker et al. Further, even if such disclosures were combined, Applicant's claimed coated panel would not result.

In addition, for the reasons expressed above, there is no sufficient evidentiary basis supporting the obviousness of Applicant's claimed coated structure based on the "general knowledge" or "understanding" of one skilled in the art. See *In re Zurko*, supra.

The same applies with respect to the dependent claims. The use of glass or plastic in the combination set forth by Applicant in amended claim 1 as set forth in claims 2 and 3 is also not disclosed or suggested by either of these references taken alone or in combination. Likewise, the use of specific layers and indices of refraction as set forth in claims 8-10, 53 and 54 in the combination of claim 1, as amended, is also not shown or disclosed in these references or their combination. With respect to claims 15 and 25, as noted above, Byker et al. does not disclose the use of transparent conductive coatings on both surfaces of a substrate, nor does Denton. And, for the reasons expressed above, Matsufuji et al. '250 also fails to disclose such a combination or the motivation or suggestion for combining its differing multiple layers on a substrate with either Byker et al. or Denton to arrive at Applicant's claimed coated panel. Therefore, it is respectfully submitted that taken alone or in combination, Applicant's amended claims 1-3, 8-10, 15, 17, 18, 25, 53 and 54 are not obvious in view of Byker et al., Denton or Matsufuji et al. taken alone or in any combination.

With respect to new claims 55-58, the combinations set forth in Applicant's amended claims 1 and 18, together with the angle dipped thin films/layers of claims 55 and 57 and the sputtered thin film/coating set forth in claims 56 and 58, are clearly not disclosed or suggested in any of the cited references taken alone or in combination. Therefore, for similar reasons to those set forth above, it is respectfully submitted that claims 55-58 are also in condition for allowance.

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Accordingly, reconsideration and allowance of amended claims 1-3, 8-10, 15, 17, 18, 25, and 53-58 is respectfully requested. A notice to that effect is earnestly and respectfully requested.

Respectfully submitted,

CATHERINE A. GETZ

By: Van Dyke, Gardner, Linn & Burkhart, LLP

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Date


Catherine S. Collins
Registration No. 37 599
2851 Charlevoix Drive, S.E.
P.O. Box 888695
Grand Rapids, MI 49588-8695
(616) 975-5500

DSG/ram